

RESPONSE

The Examiner states in the Office Action Summary that claims numbered 1, 2, 7, 17, 45-47, and 53-55 are pending in the application; claims numbered 1, 2, 7, 17, 46, 47, and 53-55 are rejected; and claim number 45 is objected to.

(1) The Examiner has rejected claims numbered 1, 2, 7, 17, 46, 47, and 53-55 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Specifically: (a) the Examiner states the claim 1 recites the limitations of “C₁₋₇-alkyl, C₂₋₇-alkenyl, C₂₋₇-alkynyl, C₁₋₇-alkoxy”, which has no support in the original disclosure. The Examiner further states “Although C₁₋₇ or C₂₋₇ falls within the range of C₁₋₁₂ disclosed in the specification, there is no preferred embodiment for selecting a narrower range. Thus, said limitations lack written description as well as enablement.”

Applicant respectfully directs the Examiner’s attention to the specification as originally filed beginning on page 6, line 10, and particularly page 8, lines 13-17, wherein the preferred embodiments “C₁₋₇-alkyl, C₂₋₇-alkenyl, C₂₋₇-alkynyl, C₁₋₇-alkoxy”, are presented.

Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

(2) The Examiner has rejected claim number 53 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Specifically: (a) the Examiner states claim 53 recites the term “ailments” which has no description as to what diseases would be included.

Applicant has cancelled claim number 53, thereby obviating this rejection.

Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

(3) The Examiner has rejected claim number 53 under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, because the claimed invention is not supported by either a specific asserted utility or a well established utility.

Applicant has cancelled claim number 53, thereby obviating these rejections.

Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph.

(4) The Examiner has rejected claim number 54 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically: there is no reasonable assurance that such a diverse genus of compounds may be useful in treating a plethora of diseases. That is, there is no correlation between the alleged utility and the screening tests. *In re Fouché*, 169 USPQ 4[2]9 (CCPA 1971).

Applicant has amended claim number 54 to remove the phrase “nuclear receptors, in particular”. Applicant respectfully asserts the Examiner’s rejection is thereby obviated and respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

(5) The Examiner has rejected claims numbered 53 and 54 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically: (a) the term “ailments” does not have definite metes and bounds; and (b) the phrase “conditions mediated by nuclear receptors, in particular the Peroxisome Proliferator-Activated Receptors (PPAR),” is unclear.

Applicant has cancelled claim number 53 and amended claim number 54 thereby obviating these rejections under 35 U.S.C. §112, second paragraph. Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

(6) The Examiner has objected to claim number 45 as being dependent on a rejected base claim.

Applicant respectfully asserts the rejection to the base claim has been overcome by the argument presented herein and respectfully requests reconsideration and withdrawal of the objection.

In view of the above, Applicant respectfully submits all claims are in condition for allowance. The Examiner is hereby invited to contact the undersigned by telephone if there

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are any questions concerning this amendment or application. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in cursive script, reading "Rosemarie R. Wilk-Orescan", written over a horizontal line.

Date: February 4, 2004

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